

## REMARKS

### *New Counsel of Record*

The power of attorney to Gordon E. Nelson has been revoked. The attorneys and agents associated with Customer Number 22830 (Carr & Ferrell LLP) have been appointed new counsel of record. A *Notice of Acceptance of Power of Attorney* issued on February 8, 2006. The Examiner's assistance is respectfully requested in ensuring that all future communication concerning this application is directed to new counsel of record. New counsel looks forward to working with the Examiner in bringing prosecution of the present application to a mutually agreeable conclusion.

### *Information Disclosure Statement*

Applicants have submitted, herewith, an *Information Disclosure Statement* compliant with 37 C.F.R. § 1.97. Applicants have also submitted the requisite fee set forth by 37 C.F.R. § 1.17(p) in that the disclosure statement is being submitted pursuant to 37 C.F.R. § 1.97(c)(2). Applicants note that while a first action was mailed October 25, 2004, the Examiner has not yet mailed a *final* office action under 37 C.F.R. § 1.113; a notice of allowance under 37 C.F.R. § 1.311; or any other action closing prosecution of the present application. Consideration of the references set forth in the disclosure statement is respectfully requested.

### *Amendments to the Specification*

Applicants have amended the cross-reference section of the specification to more accurately reflect the various continuation-in-part and provisional priority claims of the present application as provided by 37 C.F.R. § 1.78(a)(1) and otherwise required by 37 C.F.R. § 1.78(a)(2)(i) and 37 C.F.R. § 1.78(a)(2)(iii).

The four-month time period limitation of 37 C.F.R. § 1.78(a)(2)(ii) does *not* apply as the present application is an application filed under 35 U.S.C. § 371 from an international application filed under 35 U.S.C. § 363 before November 29, 2000; the international application was filed June 28, 1999. As such, the surcharge and unintentional delay requirements of 37 C.F.R. § 1.78(a)(3) are *not applicable*.

In light of this amendment and the accurate reflection of priority, the Applicants respectfully traverse the Examiner's contention that "[t]his application claims the priority of 6/29/1998." *Office Action*, 2. The present application claims the benefit of Patent Cooperation Treaty application number PCT/US99/14585 filed June 28, 1999, which claims the priority benefit of U.S. provisional patent application number 60/091,130 filed June 29, 1998. The present application is also a continuation-in-part and claims the priority benefit of U.S. patent application 09/034,507 filed March 4, 1998, which claims the priority benefit of U.S. provisional patent application number 60/039,542 filed March 10, 1997 as well as U.S. provisional patent application number 60/040,262 also filed March 10, 1997.

As provided by 35 U.S.C. § 120 and 35 U.S.C. § 119(e), "a claim in a U.S. application is entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in the earlier filed application." MPEP § 201.11(I)(B) (citing *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59 (CCPA 1978)). Thus, subject to the limitations of a particular claim vis-à-vis the written description, this application may enjoy a priority benefit as early as March 10, 1997.

### ***Rejections Under 35 U.S.C. § 112, ¶ 2***

The Examiner rejected claims 8 and 10 “under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention.” *Office Action*, 2. Specifically, the Examiner contends that the claim language “a further condition **may be** associated in the database with the given policy” makes it “unclear what includes and excludes condition in (sic) database with the given policy.” *Office Action*, 2 (emphasis in the original). The Applicants have amended claims 8 and 10 to remove the purportedly offending ‘may be’ language. As such, the Examiner’s rejection is moot and withdrawal of the rejection is respectfully requested.

### ***Rejections Under 35 U.S.C. § 103(a)***

The Examiner rejected claims 1-13 “under 35 U.S.C. § 103(a) as being unpatentable over Schneider et al [Schneider, 6,678,835 B1] in view of Reid et al [Reid, 6,182,226 B1].” *Office Action*, 2. The Applicants respectfully traverse.

As an initial matter, the Applicants note that Schneider et al is actually U.S. patent number 6,408,336 and *not* U.S. patent number 6,678,835 as noted by the Examiner in the *Office Action*. See *Office Action*, 2. Notwithstanding this typographical error, the Applicants believe the Examiner intended to refer to Schneider et al. (6,408,336) as (1) the Examiner’s citations in the *Office Action* contextually correspond to U.S. patent number 6,408,336 and *not* to U.S. patent number 6,678,835 and (2) while there is an entry for U.S. patent number 6,408,336 in the *Notice of References Cited* that accompanied the *Office Action*, there is *no such entry* for U.S. patent number 6,678,835. As such, the Applicants have responded to this rejection under the presumption that U.S. patent number 6,408,336 to Schneider et al. is the reference utilized by the Examiner in making the aforementioned rejection.

With regard to the merits of the Examiner's rejection, the Applicants respectfully traverse the propriety of this rejection in that U.S. patent number 6,408,336 to Schneider et al. is the *parent of the present application*. As noted in the cross-reference section, "the present application is also a continuation-in-part and claims the priority benefit of U.S. patent application 09/034,507 filed March 4, 1998 and now U.S. patent number 6,408,336."

U.S. patent number 6,408,336—through this priority claim—cannot serve as any sort of prior art reference against the present application. In this regard, the use of Schneider et al. as a prior art reference is legally improper under 35 U.S.C. § 102 or 35 U.S.C. § 103. As each and every one of the Examiner's 35 U.S.C. § 103(a) are, in part, based on the Schneider et al. reference, the Applicants respectfully request the Examiner's rejection be withdrawn.

## CONCLUSION

The Applicants have amended the cross-reference section to more accurately reflect the continuity and priority relationships of the present application. The provisions of 37 C.F.R. § 1.78(a)(2)(ii) are not applicable.

The Applicants have deleted the purportedly indefinite language identified by the Examiner in claims 8 and 10. The Applicants, therefore, respectfully request that the rejection be withdrawn.

The use of Schneider et al. as a prior art reference is improper in light of the continuity relationship of the present application to Schneider et al. As each and every one of the Examiner's 35 U.S.C. § 103(a) rejections rely upon the disqualified Schneider et al. reference, the Applicants contend the Examiner's 35 U.S.C. § 103 rejections to have been overcome.

Applicants amendments to the claims are not made with regard to overcoming any particular reference previously identified by the Applicant, the Examiner or otherwise of record in the present application.

In light of the Applicants having overcome the Examiner's 35 U.S.C. §§ 112 & 103 rejections, the Applicants respectfully request the passage of the present application to issue. The Examiner is invited to contact the Applicants' undersigned representative with any questions concerning this application.

Respectfully submitted,  
Clifford L. Hannel et al.

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